

skill in the art at the time the invention was made to select an optimized combination of crushable particles for the barrier layer and suitable pressure sensitive adhesives with the proper thermal properties to make the surface covering. The PTO further asserts that it would have been obvious to one of ordinary skill in the art to distribute or place in a pattern the non-adhesive, crushable particles in the barrier layer.

The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *Burlington Indus., Inc. v. Quigg*, 822 F.2d 1581, 1584, 3 U.S.P.Q.2d 1436, 1439 (Fed. Cir. 1987). Initially, the PTO bears the burden of establishing the *prima facie* case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed Cir. 1984). To establish a *prima facie* case, the PTO must satisfy three requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgem, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209, 18 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art reference or combination of references must teach or suggest all the limitations of the claims. See *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). To support a conclusion of obviousness, "either the references must expressly or impliedly suggest the claimed combination or the [PTO] must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int. 1985). In evaluating obviousness, the Federal Circuit

made it very clear that one must look to see if "the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have had a reasonable likelihood of success viewed in light of the prior art." *In re Dow Chemical Co. v. American Cyanamid Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *Id.*

*Keely et al.* is noted by the PTO as teaching all the features of the claimed invention except for the specific pressure required to crush the non-adhesive particles of the barrier layer.

Specifically, the PTO asserts that it would have been obvious to one having ordinary skill in the art at the time the invention was made to select an optimized combination of crushable particles for the barrier layer and suitable pressure sensitive adhesives with proper thermal properties to make the surface coverings. The PTO further notes that it has been held that where general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 U.S.P.Q. 233.

Applicant respectfully asserts that *Keely et al.* does not teach or suggest the claimed crush resistance value of 10 psi for the non-adhesive particles claimed in the present application. *Keely et al.* teaches the addition of hollow glass bubbles to an adhesive layer of a wall covering. Furthermore, *Keely et al.* does not teach or suggest the use of other than hollow glass bubbles embedded into an adhesive layer. *Keely et al.* is directed to repositionable wall coverings, while the present application is directed to preventing an article from sticking to an adjacent article during storage and under certain loads.

The present application claims an adhesive layer having a crush resistance of at least 10 psi. Self-adhering surface coverings are often packaged in cartons with 20-50 tiles per cartoon

weighing about 10-65 pounds and typically stored in stacks of three boxes or more. The recited claim limitation of at least 10 psi for crush resistance provides adequate resistance to substantially withstand the forces placed upon the particles when the tiles are stacked and stored. In contrast to the present application, *Keely et al.* teaches that the hollow glass bubbles are crushed using a moderate amount of pressure. Furthermore, excessive pressure is said to cause damage to the decorative sheet of the wall covering. *Keely et al.* is directed to wallpaper having hollow glass bubbles that can be crushed using a roller, while the present application is directed to a self-adhering floor covering having embedded particles that can be crushed with the force of a heel. Thus, the *Keely et al.* reference does not teach or suggest the claimed crush resistance value of the present application.

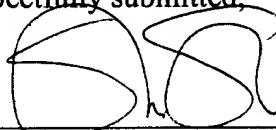
Furthermore, it would not have been obvious to one skilled in the art to select an optimized combination of crushable particles for the barrier layer as is asserted within the Official Action. As discussed above, *Keely et al.* is directed to a wall covering having hollow bubbles which are crushable using a roller applied to the wall surface. The cited art does not disclose particles embedded within an adhesive layer for preventing tiles from adhering to each other during storage. One skilled in the art would not optimize the crush resistance of the *Keely et al.* wall covering to withstand the stacking force equivalent to several cartons of flooring tiles stacked one upon another. Within the cited reference, the hollow glass bubbles taught in *Keely et al.* are said to be of the type which have sufficient strength to allow mixing with an adhesive by ordinary means, such as stirring under moderate conditions. Col. 6, Lines 21-24. Essentially, the only limitation placed on the strength of the hollow glass bubbles taught in *Keely et al.* is that they must stand up to stirring under moderate conditions. Thus, one skilled in the art would not

be motivated to optimize the glass bubbles taught in *Keely et al.* to withstand the pressures experienced in stacked cartons flooring tiles, or the claimed range of at least 10 psi.

Thus, *Keely et al.* does not render claim 18 of the present invention obvious and it is respectfully requested that the rejection of this claim be withdrawn. Furthermore, since claims 19-34 depend from and have further limitations in excess of base claim 18, claims 19-34 should also define over *Keely et al.* as a matter of law.

Thus, Applicant respectfully submits that claims 18-34 of the application are believed to be in a condition for allowance and an early notice to such effect is earnestly solicited.

Respectfully submitted,



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May 13, 2002

Cheryl West

## APPENDIX

31. (Once Amended) The surface covering as claimed in claim 18, wherein pressure-sensitive adhesive layer [is] comprises an adhesive selected from natural rubber adhesives, synthetic rubber adhesives, acrylic adhesives, vinyl acetate adhesives, urethane adhesives, and mixtures thereof.